

REMARKS

Overview

The Examiner responded in the prior Office Action as follows: rejected claims 53-54 and 56 under 35 U.S.C. § 102(a) as being anticipated by Cyber Media (European Patent Application No. EP 0 811 942 A2); rejected claim 55 under 35 U.S.C. § 103(a) as being unpatentable over Cyber Media in view of Kirouac (U.S. Patent No. 5,155,847); rejected claim 57 under 35 U.S.C. § 103(a) as being unpatentable over Cyber Media in view of a Siebel Systems document ("Siebel Systems: Siebel announces production shipment of Siebel Enterprise Applications Version 3.0"); rejected claims 58-59 and 61 under 35 U.S.C. § 103(a)* as being unpatentable over Cyber Media in view of an entry in the Dictionary of Computing; rejected claim 60 under 35 U.S.C. § 103(a)* as being unpatentable over Cyber Media in view of Kirouac and the Dictionary of Computing entry; and rejected claim 62 under 35 U.S.C. § 103(a)* as being unpatentable over Cyber Media in view of the Siebel Systems document and the Dictionary of Computing entry. Applicants note that the claim rejections indicated with "(*)" were incorrectly recited in the prior Office Action as being based on 35 U.S.C. § 102(a), but are treated by Applicants for purposes of this response as being based on 35 U.S.C. § 103(a) due to the combinations of references cited to support these rejections.

Applicants hereby amend claims 53-60 in order to clarify the subject matter of their invention, and further hereby cancel claims 61 and 62. Thus, claims 53-60 are now pending.

Analysis

Applicants' Priority Claim

As a threshold matter, Applicants note that the Examiner's acknowledgment of Applicants' claim for priority is unclear, and request that the Examiner clarify that the priority claim made for the current application at the time of filing is effective. In particular, the Examiner noted in the prior Office Action that "[a]cknowledgment is made

of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in WIPO on 3 March 1999, [but the priority claim] . . . cannot be based on said application, since the United States application was filed more than twelve months thereafter." However, the Examiner appears to have mistaken Applicants' priority claim as being based upon 35 U.S.C. § 119, when in fact the priority claim is based on 35 U.S.C. § 120 – in particular, the priority claim added to the application at the time of filing indicated "[t]his application claims priority under 35 U.S.C. § 120 . . . ". Thus, since the U.S.-filed priority PCT application was pending at the time of the filing of the current application, the priority claim under 35 U.S.C. § 120 is proper, and Applicants request that the Examiner acknowledge the validity of Applicants' priority claim.

Rejections Based On Prior Art

With respect to the rejections of the previously pending claims based upon the cited prior art references, the Examiner has rejected each of the previously pending claims as being unpatentable over the Cyber Media reference, either alone or in combination with other references. However, each of the pending claims as rejected includes features and provides functionality not disclosed by Cyber Media or the other references. Thus, each of the pending claims as rejected is allowable.

In particular, with respect to independent claims 53 and 58 as rejected, both claims recited the use of "software version upgrade kits" that include all the information needed "to upgrade one or more software components from one version to another version", including "files, actions, and an upgrade wizard". In addition, after storing the contents of the upgrade kits in a table of contents and determining that a client needs one of more upgrade kits to perform upgrades, the claims further recite "building the software upgrade kits from the table of contents" and "downloading copies of the software upgrade kits from the server to a client to be upgraded". Claims 53 and 58 as amended continue to recite similar language.

Conversely, none of the prior art references describe such self-contained upgrade kits, and further do not teach or suggest that the server computer builds and downloads copies of such upgrade kits for clients as needed. Instead, Cyber Media

merely describes that a service provider computer system stores a list of software updates that are available from third-party vendors so that a client computer can be directed to the appropriate third-party vendor computer to obtain a desired software upgrade. While the information on a third-party vendor's computer may include files, Applicants can find no mention in the prior art references of having self-contained upgrade kits that further include lists of actions to perform and an upgrade wizard to perform actions and use files as appropriate. Furthermore, the other prior art references do not appear to remedy this failing of Cyber Media, and thus the rejected and pending claims as amended are patentable over the cited prior art for at least this reason.

Moreover, several of the previously pending dependent claims recited additional features and functionality that are not taught or suggested by the prior art references. For example, previously pending dependent claim 56 recited "downloading one or more upgrade kits to a client before the client requires the upgrade", and dependent claim 61 recited similar language. As another example, previously pending dependent claim 57 recited that "the software being upgraded is database management software, and the upgrades further include database schema changes", and dependent claim 62 recited similar language. Moreover, independent claim 58 as amended recites similar language related to upgrading database schema (including downloading and using copies of one or more upgrade kits "that upgrade the database schema for the partially replicated database on the client computer") and to pre-loading of upgrade kits before they are needed by a client (including building and downloading copies of "additional upgrade kits for performing upgrades of software components on the client computer that are not needed for the database management software program" and downloading them to the client while it is docked with the server, and "subsequent to the docking of the client computer with the server computer, determining that the client computer needs one or more of the software component upgrades corresponding to the additional upgrade kits and performing those one or more upgrades based on the previously downloaded additional upgrade kits").

With respect to the pre-loading of upgrade kits on a client computer before they are needed by the client computer, the Examiner has argued that Cyber Media anticipates such claims, citing the following passage:

The user profile database 711 maintains a profile for each user containing information about which products the user has shown an interest, for example by requesting notification about software updates for specific products, or about new software products. This information is then used to deliver notification about new updates available for these products to the user, for example by email, or other electronic communications mechanisms. This optional feature of the service provider computer 102 further enhances the value of the service to the user, ensuring timely notification of the availability of software updates and new software products.

Cyber Media, 14:1-8.

However, this passage makes clear that Cyber Media merely describes that a user can request to receive an email notification when an upgrade becomes available, so that the user could then go and retrieve the available upgrade when desired. Thus, not only does this functionality not teach or suggest the recited claim elements of pre-loading upgrade kits on client computers before they are needed, it teaches away from the recited functionality because it is directed to the opposite objective from that of the recited claim elements, focusing instead on providing on-demand software upgrades to users. Furthermore, in embodiments in which a client computer is only periodically docked with the server computer, such as that recited in independent claim 58, a client using the described Cyber Media technique would be unable to obtain and perform a needed upgrade that becomes available when the client is not docked until the next time that such docking occurs, thus rendering useless the benefits provided by Applicants' claimed invention. Therefore, for these reasons as well, claim 56 as previously presented and amended and independent claim 58 as amended are patentable.

With respect to using upgrade kits to upgrade database schema on a client computer, the Examiner has argued that the Siebel Systems document renders such claims obvious. However, even if the Siebel Systems document does disclose the idea of upgrading database schema, the Examiner has provided no basis for why it would be obvious to use self-contained upgrade kits to upgrade database schema on a client computer in the manner recited. Thus, for this reason as well, claim 57 as previously presented and amended and independent claim 58 as amended are patentable.

The pending dependent claims include the features of those claims from which they depend, and are thus allowable for the same reasons as those claims. Moreover, the pending dependent claims also recite additional features lacking in the cited references, and are thus allowable on the basis of those features as well, although these additional features are not enumerated here for the sake of brevity.

Conclusion

In light of the above remarks, Applicants respectfully submit that all of the pending claims are allowable. Applicants therefore respectfully request the Examiner to reconsider this application and timely allow all pending claims. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 264-6380.

Respectfully submitted,
Perkins Coie LLP



James A. D. White
Registration No. 43,985

JDW:

Enclosures:
Postcard
Transmittal

1201 Third Avenue, Suite 4800
Seattle, Washington 98101-3099
(206) 359-8000
Fax: (206) 359-9000